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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/644,049	08/19/2003	David D. Cox	16011/103/105	5136

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EXAMINER

GHALI, ISIS A D

ART UNIT

PAPER NUMBER

1615

DATE MAILED: 01/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/644,049

Applicant(s)

COX ET AL.

Examiner

Isis Ghali

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-29 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 22-29 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

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DETAILED ACTION

The receipt is acknowledged of applicants' preliminary amendment and drawings, filed 03/05/2004.

Claims 1-21 have been canceled and claims 22-29 have been added and included in the prosecution.

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 22-29 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-19 of U.S. Patent No. 5,829,442; claims 1-21 of U.S. Patent No. 6,216,699; claims 1-4 of U.S. Patent No. 6,503,531; and claims 1-4 of U.S. Patent No. 6,607,746. Although the conflicting claims

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are not identical, they are not patentably distinct from each other because the claims of each of the issued patents and the present claims are all directed to hot melt adhesive composition comprising acrylic polymer and antimicrobial agent dispersed therein. It is anticipatory type double patenting rejection.

3. Claims 22-29 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of copending Application No. 10/717,380. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claims and the potentially conflicted claims are directed to composition comprising acrylic polymer and antimicrobial agent dispersed therein. It is an anticipatory double patenting rejection because the present claim anticipated at least claim 1 of the copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 22-29 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for diiodomethyl-p-tolylsulfone as antimicrobial agent dispersed in acrylic polymer, does not reasonably provide enablement for all

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antimicrobial agents. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to practice the invention commensurate in scope with these claims.

The factors to be considered in determining whether a disclosure meets the enablement requirement of 35 U.S.C. 112, first paragraph, have been described in *In re Wands*, 8 USPQ2d 1400 (Fed. Cir. 1988). Among these factors are: the nature of the invention; the breadth of the claims; the state of the prior art; the relative skill of those in the art; the amount of direction or guidance presented; the predictability or unpredictability of the art; the presence or absence of working examples; and the quantity of experimentation necessary. When the above factors are weighed, it is the examiner's position that one skilled in the art could not practice the invention without undue experimentation.

The nature of the invention: The nature of the invention is a hot melt adhesive composition comprising diiodomethyl-p-tolylsulfone dispersed in acrylic polymer. The entire specification discloses diiodomethyl-p-tolylsulfone as antimicrobial agent. Nowhere in the specification applicants have disclosed any antimicrobial agent other than diiodomethyl-p-tolylsulfone.

The breadth of the claims: The claims are very broad. The claims encompass broad classes of antimicrobial agents that encompass antifungal, antiviral, antibacterial, antibiotics, etc.

The state of the prior art: The state of the art does not recognize hot melt adhesive composition comprising diiodomethyl-p-tolylsulfone dispersed acrylic polymer.

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The art recognized emulsion comprising acrylic polymer and diiodomethyl-p-tolylsulfone, US 5,500,470.

The relative skill of those in the art: The relative skill of those in the art is high.

The amount of direction or guidance presented: The specification provides no guidance, in the way written description, on antimicrobial agents other than diiodomethyl-p-tolylsulfone dispersed in the hot melt acrylic adhesive composition. It is not obvious from the disclosure of diiodomethyl-p-tolylsulfone dispersed in hot melt acrylic adhesive if the other antimicrobial agent will work and will stand the high temperature of the hot melt. *In re Dreshfield*, 110 F.2d 235, 45 USPQ 36 (CCPA 1940), gives this general rule: "It is well settled that in cases involving chemicals and chemical compounds, which differ radically in their properties it must appear in an applicant's specification either by the enumeration of a sufficient number of the members of a group or by other appropriate language, that the chemicals or chemical combinations included in the claims are capable of accomplishing the desired result." The article "Broader than the Disclosure in Chemical Cases," 31 J.P.O.S. 5, by Samuel S. Levin covers this subject in detail. A disclosure should contain representative examples which provide reasonable assurance to one skilled in the art that the compounds fall within the scope of a claim will possess the alleged activity. See *In re Riat et al.* (CCPA 1964) 327 F2d 685, 140 USPQ 471; *In re Barr et al.* (CCPA 1971) 444 F 2d 349, 151 USPQ 724.

The predictability or unpredictability of the art: The lack of guidance from the specification and from the prior art with regard to hot melt adhesive composition comprising acrylic polymer and diiodomethyl-p-tolylsulfone dispersed in there makes

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practicing the claimed invention unpredictable in the terms of using other antimicrobial agents that may be heat sensitive.

The presence or absence of working examples: The specification discloses only diiodomethyl-p-tolylsulfone dispersed in heat melted acrylic adhesive. No working examples to show using other antimicrobial agents in hot melt adhesive comprising acrylic polymer. Therefore, the specification has enabled diiodomethyl-p-tolylsulfone dispersed in hot melt of acrylic polymer.

The quantity of experimentation necessary: The art demonstrates diiodomethyl-p-tolylsulfone dispersed in emulsion of mixture of acrylic polymers. Therefor, the practitioner would turn to trial and error experimentation to practice the instant composition without guidance from the specification or the prior art. Therefore, undue experimentation becomes the burden of the practitioner.

Election/Restrictions

6. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 22-28, drawn to hot melt adhesive for skin application, classified in class 424, subclass 448.
 - II. Claim 29, drawn to solventless adhesive composition, classified in class 524, subclass 204.

The inventions are distinct, each from the other because of the following reasons:

7. Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different functions because the composition of Group I is adapted for skin use as a wound dressing or drug delivery device, while the composition of Group II can be used for packaging and not for application to the skin. Furthermore, the different inventions have distinct requirement because Group I does not exclude the solvent while Group II is solventless and does not necessary a hot melt adhesive, it could be a blend.

8. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

9. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

10. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim

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remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Isis Ghali whose telephone number is (571) 272-0595. The examiner can normally be reached on Monday-Thursday, 7:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached on (571) 272-0602. The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Isis Ghali
Examiner
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